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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,802	01/11/2001	Mario Rosario Carlone JR.	1334	9354

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EXAMINER
FOX, DAVID T

ART UNIT	PAPER NUMBER
1638	4

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
9/758,802	Carlone et al
Examiner	**Group Art Unit**
FOA	1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-49 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-49 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

Applicants' intent on page 49 of the specification to deposit under all of the conditions of 37 CFR 1.801-1.809 is acknowledged.

Claims 1, 6, 21, 25, 37 and 40 are objected to for their inclusion of blanks "_____". It is assumed that the blanks will be replaced by the ATCC deposit accession number.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5, 14, 16, 19, 20, 22, 24, 33, 35, 41, 43, 45, 46 and 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 22 are indefinite in their recitation of "wherein said plant is male sterile" which is confusing, since the claims from which they depend are not drawn to a male sterile plant. Replacement of the phrase with --further comprising a genetic factor conferring male sterility-- would obviate this rejection.

Claims 5 and 24 are indefinite in their recitation of "the...protoplasts" which lacks antecedent basis in the claims from which they depend. Deletion of "the" before "cells" in line 1, and insertion of --of the tissue culture-- after "protoplasts" in line 1, would obviate this rejection.

Claims 14, 33, 41, 45 and 46 are indefinite in their recitation of "good", "high", "excellent", "above average" and "adapted" which are unduly narrative and so fail to clearly

characterize the degree of expression of the claimed trait or the claimed maize plant exhibiting the trait.

Claims 16 and 35 are indefinite in their recitation of "[t]he maize plant breeding program" since the claims from which they depend are drawn to methods rather than breeding programs. Replacement of the phrase with "[t]he method" would obviate this rejection.

Claims 19-20 and 48-49 are indefinite in their recitation of "[t]he single gene conversion(s) of claim" since the preceding claims are drawn to maize plants rather than single gene conversions. Replacement of "conversion(s)" with --conversion--, and insertion of --maize plant-- after "conversion", would obviate this rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14, 33, 43 and 45-46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson (U.S. 5,824,849).

The claims are drawn to maize plants exhibiting two traits and which are derived from the exemplified maize inbred following an unspecified number of crosses for an unspecified number of generations with other plants of unspecified genetic complements, wherein at least one parent was the exemplified maize plant.

Johnson teaches an inbred maize plant developed in Iowa with high yield and adapted to the Central Corn Belt region of the United States (see, e.g., columns 9-10, Table 1). The plant taught by Johnson differs from the claimed plant only in the derivation from a particular maize parent. However, the method of making the maize plant would not confer a unique characteristic to the resultant plant which would distinguish it from the prior art plant, given the loss of parental genotypic contribution with each outcross. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 5,824,849).

Johnson teaches an inbred Dent maize plant with yellow endosperm, dark anthocyanin in the brace roots, pink silk, green glume, and upright ear (see, e.g., Table 5, columns 16-17), wherein the plant was developed by crossing other breeding lines exhibiting desirable traits, wherein tissue culture or genetic engineering may be further employed to introduce other traits, and wherein the inbred can be used to produce other desirable hybrids (see entire patent).

Johnson does not teach a maize plant with dark green leaves.

It would have been obvious to one of ordinary skill in the art to utilize the maize plant taught by the reference and to modify that plant by breeding with other maize plants to incorporate other desirable agronomic traits, as suggested by the reference.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

March 11, 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180

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